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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,557	07/16/2001	Takahiko Ishiguro	Q65441	6024

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EXAMINER

SAKELARIS, SALLY A

ART UNIT PAPER NUMBER

1634

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/904,557

Applicant(s)

ISHIGURO ET AL.

Examiner

Sally A Sakelarlis

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 16 June 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 13-16.Claim(s) rejected: 10-12.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

JEFFREY FREDMAN  
PRIMARY EXAMINER

7/19/04

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments are not convincing to overcome the rejections of claims 10-12 made of record in the final rejection of 12/9/2003. Applicant first argues that Jones et al. does not teach a method for determining whether a selected DNA molecule is expressed. As stated in the final rejection on page 3, it is maintained that Jones et al. anticipates the limitations of claims 10 and 12. During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See also MPEP § 2112 - § 2112.02. The preamble of claim 10 does not result in a manipulative difference between the claimed invention and the prior art. Even if *arguendo*, the claim requires that the method determines an unknown gene expression region or similarly that it is the first time a determination of a gene expression region is made, such an implication does not result in a manipulative difference between the invention and the prior art. Applicant further argues that Claim 12 is not anticipated by Jones et al. Again it is maintained that the reference meets all of the actual process steps in claim 12 and is able to achieve the same goal considering the preamble does not breath life and breadth into claims 10 and 12. Lastly, applicant argues that claim 11's limitation of a DNA molecule consisting of from 100-200 nucleotides, is not obvious over the 244 nt EST(W17142) of Jones et al. Applicant's arguments are not found to be convincing as a substitution of one well known method/reagent with known properties for a second well known method/reagent with well known properties would have been *prima facie* obvious to the ordinary artisan at the time of the invention in the absence of an unexpected result(See also MPEP 2144.07 and 2144.09). Furthermore, the remaining rejections/objections are also maintained for reasons of record in view of the final rejection .

Continuation of 7. The amendment clarifying the dependency of claim 16 does not change the rejections and objections made of record in the case.